



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

04329.1949-01

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/023,849

Filed

12/21/2001

First Named Inventor

Atsushi YAGISHITA

Art Unit

2822

Examiner

Rose, Kiesha L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record. 53,235
Registration number _____ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

David M. Longo

Typed or printed name

202-408-4489

Telephone number

08/25/2005

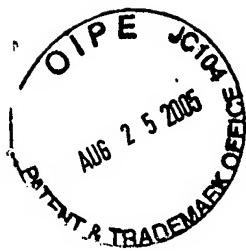
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

 *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT
Customer No. 22,852
Attorney Docket No. 04329.1949-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Atsushi YAGISHITA et al.) Group Art Unit: 2822
Application No.: 10/023,849) Examiner: Rose, Kiesha L.
Filed: December 21, 2001) Confirmation No. 4501
For: SEMICONDUCTOR DEVICE)

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejections in the Office Action mailed on June 3, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

Remarks begin on page 2 of this paper.

REMARKS

Claims 30-39 remain pending and under current examination, with claims 30-37 standing allowed, and claims 38 and 39 being the subject of this Pre-Appeal Brief Request for Review. In the 06/03/2005 Office Action, the Examiner rejected claim 38 under 35 U.S.C. § 102(e) as being anticipated by “Applicant’s Prior Art (Figs. 2a/2b)” (“AAPA”); allowed claims 30-37; objected to claim 39 as dependent upon a rejected base claim, but allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims; withdrew the finality of the previous Office Action of 01/13/2005; and withdrew the previous 35 U.S.C. § 112, first paragraph, rejections of claims 38 and 39, based on the Examiner interview conducted on May 17, 2005.

Rejection of Claim 38 under 35 U.S.C. § 102(e):

The Examiner’s rejection contains clear errors and omits the essential elements necessary for a *prima facie* case of anticipation of Applicants’ claim 38.

A proper 35 U.S.C. § 102(e) rejection requires that each and every element of each of the claims in issue be found, either expressly described or under principles of inherency, in a single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *See M.P.E.P. § 2131*, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Since AAPA does not disclose each and every element of claim 38, the rejection is improper. For the reasons that follow, the Examiner’s allegations fail to satisfy the essential elements of a proper anticipation rejection.

The reasoning presented below will establish that at least the element “a remaining region of said pair of thin films on which said gate sidewall is absent,” recited in claim 38, is not

disclosed in AAPA. An example of an embodiment consistent with claim 38 is shown in Fig. 22K. A comparison of Fig. 22K with AAPA Figs. 2A/2B will illustrate that AAPA fails to disclose at least “a remaining region of said pair of thin films on which said gate sidewall is absent,” recited in claim 38. The invention of course is not limited to the example shown in Fig. 22K. The discussion of Fig. 22K, set forth below, is presented solely for the purpose of illustrating that at least the claim element “a remaining region of said pair of thin films on which said gate sidewall is absent,” recited in claim 38, is not present in AAPA.

In part of the Examiner’s allegations on pages 2-3 of the 06/03/2005 Office Action, the Examiner alleges that there exists “a remaining region of [said] pair of thin films (region under diffusion region 6 (area to the left of portion 5 in Fig. 2b)) on which [said] gate sidewall is absent...” An examination of AAPA Figs. 2A/2B shows this to be wholly incorrect.

AAPA Figs. 2A/2B show, for example, that prior art insulating gate sidewall 4 extends beyond the pair of thin films 5 and **partially overlaps** the top of deeper n⁺-type diffusion region 6. In the context of AAPA Figs. 2A/2B, gate sidewall 4 is present over part of n⁺-type diffusion region 6 (e.g. the remaining region of said pair of thin films 5 in Figs. 2A/2B), and hence is not absent.

In contrast, an embodiment of Applicants’ invention shown in Fig. 22K, corresponding to independent claim 38, shows a gate sidewall 207 that **does not at all overlap** any of n⁺-type diffusion regions 208. The “remaining region” recited in claim 38, as shown in Fig. 22K, is n⁺-type diffusion region(s) 208 formed adjacent to extension(s) 204 and on opposing sides of gate insulating film 210. Note that gate sidewall 207 is not present over n⁺-type diffusion region(s) 208, and hence is absent.

In the Request for Reconsideration after Final of March 29, 2005, pages 2-3, Applicants demonstrated that Fig. 22K illustrates examples of each and every element of claim 38. Thus, a comparison of AAPA Figs. 2A/2B and the language of independent claim 38 (as embodied in Fig. 22K) clearly demonstrates that AAPA does not disclose at least Applicants' claimed "a remaining region of said pair of thin films on which said gate sidewall is absent" (claim 38).

AAPA therefore does not anticipate Applicants' independent claim 38. Independent claim 38 is therefore allowable, for the reasons set forth above, and dependent claim 39 (objected to as being dependent upon rejected base claim 38) is also allowable at least by virtue of its dependence from allowable base claim 38. Therefore, the improper 35 U.S.C. § 102(e) rejection of claim 38 should be withdrawn.

Conclusion:

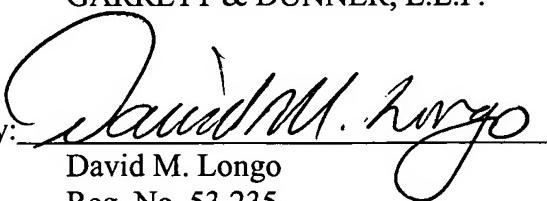
In view of the foregoing, Applicants request a pre-appeal brief review of the rejection in the Office Action mailed on June 3, 2005. Pending claims 30-39 are in condition for allowance, and Applicants request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 25, 2005

By: 
David M. Longo
Reg. No. 53,235

/direct telephone: (202) 408-4489/